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DRAFT AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/440,690
ATTORNEY DOCKET NO. Q056494

REMARKS

Claims 1-8, 11-20 and 22 are all the claims pending in the application. Claims 1-9 and 11-20 have been amended. Since the amendments to claims 1-9 and 11-20 are solely for precision of language and do not narrow said claims, no Festo estoppel should arise.

Claim 22 is a new claim. No new matter has been introduced and support for each amended claim and new claim can be found in the specification.

Rejections under 35 U.S.C. § 112, second paragraph

Examiner rejected claims 1-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amended the claims for clarification, including the terms, phrases and insufficient antecedent bases that Examiner indicated as grounds for this rejection. Applicant submits that the pending claims are no longer indefinite. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson et al. (U.S. Patent No. 6,052,512; hereinafter Peterson) in view of Shimizu (U.S. Patent No. 6,002,915; hereinafter Shimizu). Applicant respectfully traverses this rejection.

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Independent Claim 1 and dependent claims 2-13

The recitation of Claim 1 requires:

defining, by the computer, second time units that represent time periods required to execute training units of the training course;

Applicant submits that Peterson or Shimizu, alone or combination, fail to teach or suggest the above feature of Applicant's invention. The Examiner contends that column 12, lines 8-38 of Peterson teaches or suggests this feature. Applicant disagrees.

Peterson apparently discloses a "prescribed schedule," however Peterson is silent regarding whether the supervisor defines the prescribed schedule or the computer-assisted teaching system 100 defines the prescribed schedule. Applicant posits, however, that Peterson teaches or suggests that the prescribed schedule is defined by the supervisor versus the computer as recited in claim 1. (See Col. 11, lines 51-54, Col. 13, lines 29-37 of Peterson).

Further, Peterson is silent in terms of whether the prescribed schedule is defined by time periods required to *execute training units*. (emphasis added) Stated differently, the prescribed schedule could be a time period to complete the training course, not training units, as recited in claim 1. Additionally, no where in Shimizu are these limitations taught or suggested. In view of these remarks, Applicant maintains that the disclosures of Peterson and Shimizu, taken as a whole, fail to teach or suggest the above limitation in claim 1.

Even assuming *arguendo* that the "second time units" are taught or suggested by Peterson, other limitations of claim 1 are neither taught nor suggested by the prior art references relied on by the Examiner. For instance, the next limitation of claim 1 requires:

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creating a progress plan, by the computer, for the execution of the training course in dependence upon the first time units and the second time units, wherein for each training unit the progress plan specifies a time by which the trainee is to have completed the corresponding training unit;

It appears that the Examiner relies on Shimizu, column 4, lines 2-47 to account for the creation of a *progress plan and the first time units.* (emphasis added)(See page 4, lines 8-14 of Non-Final Office Action dated August 30, 2001). Applicant asserts that Examiner's position is untenable given the disclosure of Shimizu.

Shimizu discloses a trainee system whereby the trainee can book or reserve a lecture using key words such as date and hour, curriculum and/or teacher. (Col. 4 lines 2-4 of Shimizu). Based on the above disclosure of Shimizu, the Examiner states that "first time units" are taught or suggested. Simply put, a distinction does exist that the Examiner has overlooked. The length of time a trainee indicates to complete the course, and the time period a trainee specifies to spend on a training course are two different time periods. (See page 4, lines 14-22 of Applicant's specification). Examiner has commingled the two time periods into one and has injected limitations that are neither taught nor suggested by Shimizu.

Assuming, that Shimuzu does teach or suggest the "first time units" aspect of claim 1, the above disclosure bears no semblance to the limitation of creating a "progress plan." First, in light of the passages relied upon by the Examiner, no progress plan is created in Shimizu, and even if it can be said that a progress plan is taught or suggested, the progress plan is not in dependence upon the first and second time units, nor is the progress plan created by the computer as recited in claim 1. Finally, if a progress plan is taught by Shimizu or Peterson, alone or in

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combination, the prior art references fail to teach that the progress plan specifies a time to complete the training unit.

More generally, as stated above, the disclosure of Shimizu fails to teach or suggest the automatic aspects of the computer creating a progress plan and monitoring. Applicant submits that the Examiner has overlooked an important feature of Applicant's invention, as set out in the preamble and the claim language of claim 1. In contradistinction, Shimizu teaches monitoring performed by a person. (Col. 3, lines 24-25, Col. 11, lines 41-42 of Shimizu). In sum, taken individually and as a whole, the germane teachings of Peterson or Shimizu fail to teach or suggest a process that includes the creating of a progress plan and monitoring by the computer as recited in claim 1.

Given the above remarks, Applicant disputes that the prior art references taken as a whole, relied on by the Examiner, teach or suggest all the claim limitations found in claim 1. Therefore, Applicant asserts the Examiner has failed to establish a *prima facie* case of obviousness and requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Finally, Applicant contests that there lies a motivation to combine Peterson and Shimizu. "There are three possible sources of motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP §2143.01 (7th Edition); In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). Examiner states that it would have been obvious to one of ordinary skill in the art to modify Peterson. (Page 4, lines 14-17, of Non-Final Office Action, dated August 30, 2001).

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We contend that the first source can not be introduced by the Examiner because the problems to be solved with respect to each reference are so different. In Shimizu, the focus is to resolve the difficulty in matching the teaching subjects and teaching hours desired by users to the available hours of teachers. (Col. 1 lines 42-45). Indisputably, this problem bears no semblance to the problem addressed by the present invention, nor the problem dealt with in Peterson.

As for the second possible source of motivation, the prior art would not have led an artisan of ordinary skill to combine the teachings of Peterson and Shimizu. Applicant submits that Peterson is a reference that is complete and functional in itself, so there would be no reason to refer to Shimizu. Moreover, the disclosure of Peterson addresses the need of supervision by a human teacher in computer-assisted teaching systems (Col. 1, lines 27-30), and there contains no suggestion that the disclosure of Peterson or Shimizu would motivate an artisan skilled in the art to modify the system of Peterson to contain a preferred training schedule specified by the student, as suggested by Examiner.

Finally, the third possible source of motivation stems from the knowledge of persons of ordinary skill in the art. Again, the Examiner has failed to bolster the conclusion that the knowledge of persons of ordinary skill in the art provided the motivation to combine the prior art references. Instead, the Examiner merely cites “the purpose of allowing the student to select a preferred training schedule.” This however, is a benefit that arises from the claimed invention, not a motivation to provide the specific invention claimed. In other words, without hindsight knowledge of the invention itself, there is no reason of record why one of ordinary skill in the art would have modified the references in a manner to provide the proposed benefit.

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In sum, Applicant maintains the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicant respectfully requests that Examiner withdraw the rejection to independent claim 1. Dependent claims 2-8 are patentable at least by virtue of their respective dependency to independent claim 1.

Independent claim 14 and dependent claim 22

Given the similarities in limitations between independent claims 1 and 14, the above arguments apply analogously to claim 14. Additionally, with regard to dependent claim 22, it is patentable at least by virtue of its dependency to independent claim 14.

Independent claim 15 and dependent claims 16-20

Given the similarities in limitations between independent claims 1 and 15, the above arguments apply analogously to claim 15. Additionally, with regard to dependent claims 16-20, they are patentable at least by virtue of their dependency to independent claim 15.

Conclusion

In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case. Please charge any required fee, except for the Issue Fee, for such extension to Deposit Account No. 19-4880.

Respectfully submitted,


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APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 10 and 21 are canceled.

The claims are amended as follows:

1. (Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course [comprising]including at least one training unit by a computer, [characterized by the following steps] comprising:

- [definition]defining, by the computer, [of] first time units [which]that represent [the] time periods which a trainee [(3) would like]specifies to spend on [the]a training course [(2)];
- [definition]defining, by the computer, [of] second time units [which]that represent [the] time periods required to execute training units of the training course [(4)];
- [creation of]creating a progress plan, by the computer, for the execution of the training course in dependence upon the first time units and the second time units[(5)],
[where]wherein for each training unit the progress plan specifies a time by which the trainee [(3)] is [expected] to have completed the corresponding training unit; and
- monitoring, by the computer, as to whether the corresponding training unit has been completed by the time specified in the progress plan [(7)].

2. (Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 1, [characterised in that]further comprising notifying the

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trainee [(3)] [is notified if]when the corresponding training unit has not been completed by the time specified in the progress plan [(10)].

3. (Twice Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 1, [characterised in that] further comprising storing a monitoring result [is stored].

4. (Twice Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 1, [characterised in that] further comprising recreating the progress plan [is recreated (5) if]when the training unit has not been completed by the time specified in the progress plan [(9)].

5. (Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 4, [characterised in that] further comprising terminating the training course [is terminated if]when, more than once, the corresponding training unit has not been completed by the time specified in the progress plan [(9)].

6. (Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 5, [characterised in that] further comprising notifying the trainee [(3) is notified] of the termination of the training course [(10)].

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7. (Twice Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 1, [characterised in that]further comprising sending the progress plan [is sent] to the trainee [(3)] after its creation.
8. (Twice Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 7, [characterised in that]wherein in said sending comprises, making the training units [are made] available to the trainee [(3)] via a computer network [(9)].
9. (Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 8, [characterised in that]wherein in said sending comprises, making the training units [are made] available to the trainee [(3)] via at least one of an in-house computer network [(intranet)], a global computer network, an Intranet, or the Internet.
11. (Twice Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 9, [characterised in that]further comprising notifying the trainee [(3)] [is notified] via electronic mail [(e-mail)] when the corresponding training unit has not been completed by the time specified in the progress plan or that the training course has been terminated.

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12. (Twice Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 9, [characterised in that]further comprising sending the progress plan [is sent] to the trainee [(3)] via electronic mail [(e-mail)].

13. (Twice Amended) A process [(1)] for the automatic creation and monitoring of a progress plan for a training course according to Claim 9, [characterised in that]further comprising making available the progress plan [is made available] on a web page to which the trainee [(3)] has access.

14. (Twice Amended) [A control element, in particular a compact disc (CD), floppy disc or the like, for a computer on which a program is stored which can run on the computer and is suitable to execute]A program product for enabling a computer to perform the automatic creation and monitoring of a progress plan for a training course comprising:
a computer readable medium, and instructions on said computer readable medium for executing the following steps:

- defining first time units that represent time periods which a trainee specifies to spend on a training course;
- defining second time units that represent time periods required to execute training units of the training course;
- creating a progress plan for the execution of the training course in dependence upon the first time units and the second time units, wherein for each training unit the progress plan

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specifies a time by which the trainee is to have completed the corresponding training unit;

and

- monitoring as to whether the corresponding training unit has been completed by the time
specified in the progress plan.

15. (Amended) A computer for the automatic creation and monitoring of a progress plan for a training course comprising at least one unit, characterized in that the computer comprises:

- means for defining first time units that represent [the] time periods which a trainee [(3)] would like]specifies to spend on [the]a training course;
- means for defining second time units [which]that represent [the] time periods required to execute training units of the training course;
- means for [the creation]creating [by the computer of] a progress plan for the execution of the training course in dependence upon the first time units and the second time units, [where]wherein for each training unit the progress plan specifies a time by which the trainee [(3)] is [expected] to have completed the corresponding training unit; and
- means for monitoring [by the computer] as to whether the corresponding training unit has been completed by the time specified in the progress plan.

16. (Amended) A computer for the automatic creation and monitoring of a progress plan for a training course according to Claim 15, [characterised in that the computer comprises] further

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comprising a means for notifying the trainee [(3) if]when the corresponding training unit has not been completed by the time specified in the progress plan.

17. (Twice Amended) A computer for the automatic creation and monitoring of a progress plan for a training course according to Claim 15, [characterised in that the computer comprises] further comprising a means for storing [the]a monitoring result.

18. (Twice Amended) A computer for the automatic creation and monitoring of a progress plan for a training course according to Claim 15, [characterised in that the computer comprises] further comprising a means for sending the progress plan to the trainee [(3)] after its creation.

19. (Twice Amended) A computer for the automatic creation and monitoring of a progress plan for a training course according to Claim 15, [characterised in that] wherein the computer is connected to a computer network.

20. (Amended) A computer for the automatic creation and monitoring of a progress plan for a training course according to Claim 19, [characterised in that] wherein the computer is connected to at least one of an in-house computer network [(intranet)] and a global computer network.

Claim 22 is added as a new claim.

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In re application of

Frank HAGEBARTH

Appln. No. 09/440,690

Group Art Unit: 3712

Confirmation No.: Not Yet Confirmed

Examiner: K. FERNSTROM

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For: A PROCESS FOR THE AUTOMATIC CREATION AND MONITORING OF A PROGRESS
PLAN FOR A TRAINING COURSE BY A COMPUTER

PAPER(S) FILED ENTITLED:

1. Amendment under C.F. R. 1.111
2. Proposed Drawing Correction

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